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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,195	09/30/2003	Andrew Fikes	025.0366.US.UTL	7103
82402	7590	11/12/2009	EXAMINER	
Straub & Pokotylo 788 Shrewsbury Avenue Tinton Falls, NJ 07724			NGUYEN, TRI V	
			ART UNIT	PAPER NUMBER
			1796	
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			11/12/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/676,195	<b>Applicant(s)</b> FIKES ET AL.	
	<b>Examiner</b> TRI V. NGUYEN	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5,8-15,17-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5,8-15,17-28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/18/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/18/09 has been entered.

2. Claims 1, 6, 7, 16 and 29 are cancelled. The currently pending claims are Claims 2-5, 8-15, 17-28 and 30.

The IDS filed 09/18/09 has been considered. An initialed copy accompanies this action.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2-5, 8-15, 17-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

It is noted that based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to nonstatutory subject matter. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*,

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437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). In the instant case, the underlying elements of the system of claims 2-5, 8-14 such as indexer and scorer and the method of claims 15, 17-28 are directed to manipulations of data via algorithms without inducing any change in an article or a material. For example, applicants' specification seems to indicate that the functional elements are software-based (see page 7, line 1 et seq.).

### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 2-5, 8, 12-15, 17-19, 21, 22, 26-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubishi (JP 2002-073680 - cited in IDS of 09/18/09; translation provided by applicants and attached machine-based translation are referenced from hereon).

Claim 2: Mitsubishi discloses a system for automatically targeting Web-based advertisements, comprising:

(a) an indexer to identify advertisements relative to a query, wherein identified advertisements describe characteristics relative to at least one of a product and a service (§ 81, 84, 86, 102, 105 and fig 20);

(b) a scorer to score the advertisements according to match between the query and the characteristics of the identified advertisements (§87-90); and

(c) a targeting component to provide at least some of the advertisements as Web-based content (§94, 101 and fig 20), wherein a numerical score is assigned to the identified advertisements based on a degree of the match (§86-90).

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Mitsubishi discloses the claimed invention but does not explicitly disclose the numerical scoring system. Mitsubishi teaches the degree of matching between a search query term and respective word vectors registered in the advertising information database via arithmetic calculations (§ 88) and the use of numerical cutoffs (§72). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Mitsubishi, with using numerical element to evaluate the degree of matching since it was known in the art that numerical values are used to provide a quantitative evaluation. Furthermore, Mitsubishi teaches the use of a vector product as an evaluation tool and it is noted that the result of vector product is usually a scalar.

Claim 3: Mitsubishi discloses a system according to claim 2, wherein the numerical score is determined relative to at least one of a content match and a categorical match (§90).

Claim 4: Mitsubishi discloses a system according to claim 2, further comprising: a sorter to sort at least some of the identified advertisements by the numerical score (§86-90).

Claim 5: Mitsubishi discloses a system according to claim 4, further comprising: a selector to select at least some of the sorted identified advertisements relative to a predefined threshold (§86-90).

Claim 8: Mitsubishi discloses a system for automatically targeting Web-based advertisements, comprising:

(a) an indexer to identify advertisements relative to a query, wherein identified advertisements describe characteristics relative to at least one of a product and a service (§ 81, 84, 86, 102, 105 and fig 20);

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- (b) a scorer to score the advertisements according to match between the query and the characteristics of the identified advertisements (§86-90); and
- (c) a targeting component to provide at least some of the advertisements as Web-based content (§94, 101 and fig 20),
- (d) a ranker to rank the identified advertisements using a selection criteria and ordering at least some of the ranked identified advertisements (§86-90); and
- (e) a selector to select at least some of the ordered identified advertisements relative to a ranking cutoff (§86-90).

Mitsubishi discloses the claimed invention but does not explicitly disclose the ranking hierarchy. Mitsubishi teaches the degree of matching between a search query term and respective word vectors registered in the advertising information database via arithmetic calculations (§ 86-90) and the use of numerical cutoffs prior to select the advertisement to be shown (§72). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Mitsubishi, with using a ranking hierarchy to evaluate the degree of matching since it was known in the art that numerical values are used to provide a quantitative evaluation - how else would the system select the proper advertisement relative to a cutoff except via ranking relative to a cutoff?

Claim 12: Mitsubishi discloses a system according to claim 2, further comprising: an advertising creative generator to generate an advertising creative based on the characteristics of at least one such identified advertisement (§92).

Claim 13: Mitsubishi discloses a system according to claim 12, wherein the advertising creative is provided as part of the at least some of the advertisements (§92).

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Claim 14: Mitsubishi discloses a system according to claim 12, wherein the advertising creative is provided as at least one of a hint provided with at least one such identified advertisement, predefined text, a precomputed advertising creative, and a cached advertising creative (§92).

Claim 15: Mitsubishi discloses a method for automatically targeting Web-based advertisements, comprising:

- (a) identifying advertisements relative to a query, wherein identified advertisements describe characteristics relative to at least one of a product and a service (§ 81, 84, 86, 102, 105 and fig 20);
- (b) scoring the advertisements according to a degree of a match between the query and the characteristics of the identified advertisements (§86-90); and
- (c) providing at least some of the advertisements as Web-based content (§94, 101 and fig 20).

Mitsubishi discloses the claimed invention but does not explicitly disclose the numerical scoring system. Mitsubishi teaches the degree of matching between a search query term and respective word vectors registered in the advertising information database via arithmetic calculations (§ 88) and the use of numerical cutoffs (§72). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Mitsubishi, with using numerical element to evaluate the degree of matching since it was known in the art that numerical values are used to provide a quantitative evaluation. Furthermore, Mitsubishi teaches the use of a vector product as an evaluation tool and it is noted that the result of vector product is usually a scalar.

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Claim 17: Mitsubishi discloses a method according to claim 15, further comprising: determining the numerical score relative to at least one of a content match and a categorical match (§86-90).

Claim 18: Mitsubishi discloses a method according to claim 15, further comprising: sorting at least some of the identified advertisements by the numerical score (§86-90).

Claim 19: Mitsubishi discloses a method according to claim 18, further comprising: selecting at least some of the sorted identified advertisements relative to a predefined threshold (§88).

Claim 21: Mitsubishi discloses a method according to claim 15, further comprising: ranking the identified advertisements using a selection criterion; and ordering at least some of the ranked identified advertisements. Mitsubishi discloses the claimed invention but does not explicitly disclose the ranking hierarchy. Mitsubishi teaches the degree of matching between a search query term and respective word vectors registered in the advertising information database via arithmetic calculations (§ 86-90) and the use of numerical cutoffs prior to select the advertisement to be shown (§72). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Mitsubishi, with using a ranking hierarchy to evaluate the degree of matching since it was known in the art that numerical values are used to provide a quantitative evaluation - how else would the system select the proper advertisement relative to a cutoff except via ranking relative to a cutoff?



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Claim 22: Mitsubishi discloses a method according to claim 21, further comprising: selecting at least some of the ordered identified advertisements relative to a ranking cutoff (§86-90).

Claim 26: Mitsubishi discloses a method according to claim 15, further comprising: generating an advertising creative based on the characteristics of at least one such identified advertisement (§92).

Claim 27: Mitsubishi discloses a method according to claim 26, further comprising: providing the advertising creative as part of the at least some of the advertisements (§92).

Claim 28: Mitsubishi discloses a method according to claim 26, further comprising: providing the advertising creative as at least one of a hint provided with at least one such identified advertisement, predefined text, a precomputed advertising creative, and a cached advertising creative (§92).

Claim 30 describes the apparatus of the method of claim 15; thus the prior art of Mitsubishi referenced in claim 15 is used in the rejection of claim 30.

7. Claims 9-11, 23, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubishi (2003/0050863) in view of Radwin (US 2003/0050863 and Elderling (US 6216129).

Claims 9-11: Mitsubishi discloses a system according to claim 8, but does not explicitly disclose further comprising: an evaluator and selector to evaluate the selection criteria

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based on at least one of a fixed cost, variable cost, and random factor associated with one or more of the identified advertisements.

It is noted that Mitsubishi teach the feature of cost evaluation (§95-100). In an analogous art, Radwin teach the feature of fixed and variable cost evaluation (§3, 4) and Elderling teach the feature of cost evaluation based on the degree of matching (col 11, line 1-11 and col 13, lines 55-67). It would have been recognized that applying the technique of cost evaluation related to the degree of matching to the teachings of cost evaluation related to the degree of matching would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to such cost evaluation features into similar systems. Further, the valuation feature would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow for an effective pricing and selection schematic.

Claims 23-25: Mitsubishi discloses a method according to claim 21, but does not explicitly disclose further comprising: evaluating the selection criteria based on at least one of a fixed cost, variable cost, and random factor associated with one or more of the identified advertisements and selecting the advertising material based on the evaluation.

It is noted that Mitsubishi teach the feature of cost evaluation (§95-100). In an analogous art, Radwin teach the feature of fixed and variable cost evaluation (§3, 4) and Elderling teach the feature of cost evaluation based on the degree of matching (col 11, line 1-11 and col 13, lines 55-67). It would have been recognized that applying the technique of cost evaluation related to the degree of matching to the teachings of cost evaluation related to the degree of matching would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to such cost

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evaluation features into similar systems. Further, the valuation feature would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow for an effective pricing and selection schematic available to the advertisers.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubishi (2003/0050863) in view of Radwin (US 2003/0050863).

Mitsubishi discloses a method according to claim 15, but does not explicitly disclose further comprising: filtering based on country, locale, language or daily budget.

In an analogous art, Radwin discloses the use of demographic profiling in the art (page 2, parag. 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Mitsubishi, with a filter for specific characteristics and features since it was known in the art that a filter to filter the identified advertisements relative to at least one of a country, locale, language, and daily budget is used to enhance the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchase the items advertised.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRI V. NGUYEN whose telephone number is (571)272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119 and Eric Stamber can be

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reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. V. N./  
Examiner, Art Unit 1796  
November 10, 2009

/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622